

II. RESPONDENTS OFFER LITTLE DEFENSE OF THE ENABLING DISCLOSURE-FOCUSED APPROACH EXEMPLIFIED BY THE DECISION BELOW.

The petition explained (at 20–24) that the Federal Circuit’s claim interpretation case law not only perpetuates undesirable uncertainty, but violates 35 U.S.C. § 112 and its underlying purposes by countenancing the use of the enabling disclosure to narrow impliedly even the clearest of claims, as the panel majority did below.

As to Section 112, the petition explained (at 3, 21) that Congress’ deliberate decision in 1952 to set forth the claims and enabling disclosure requirements in separate paragraphs underscores that the claims are the touchstone in determining a patent’s scope. See also P.J. Federico, *Commentary on the New Patent Act*, 35 U.S.C.A. Vol. 1, p. 25 (1954) (“In the old statute the requirement for a claim pointing out what the applicant regarded as his invention appeared as a clause in the same sentence relating to the description, which led to some confounding of the nature of the two requirements in a few decisions. In the new statute the clause relating to the claim has been made a separate paragraph to emphasize the distinction between the description and the claim * * *.”).

As to policy, the petition demonstrated (at 23–24) that allowing the disclosure to narrow the claims encourages inventors to provide an opaque disclosure, thereby undermining the function of the disclosure to facilitate the public’s ability to practice and improve upon the patented invention.

The approach employed by the panel majority below (and in numerous other Federal Circuit decisions), which turns immediately to the enabling disclosure and draws from it an implicit limitation on the ordinary meaning of the claims, violates both the statute and its underlying policy.

1. Again, respondents fail almost entirely to confront these points. Their principal response — that relying on inference from the enabling disclosure to read limitations on the claims' scope does not undermine the claims because "the claims *must* be read in the context of the patent as a whole" (Opp. 13) — merely assumes the answer to the question presented.

2. The petition cited (at 22) *Smith v. Snow*, 294 U.S. 1 (1935), and *McCarty v. Lehigh Valley R. Co.*, 160 U.S. 110, 116 (1895), as examples of this Court's recognition — even before the 1952 amendment in which Congress stressed the importance of the claims as a distinct element — that "the claims of the patent, not its specifications, measure the invention." *Smith*, *supra*, at 11. Respondents do not address *McCarty*, but contend (Opp. 13–14) that the petition misreads *Smith*. In fact *Smith*, like the dissent below, correctly declined to draw any implicit limitations from the enabling disclosure and instead discerned the ordinary meaning of the claims from their text, including a comparison of one claim with another. See 294 U.S. at 13–14; Pet. App. 20a–21a. In any event, *Smith* has not prevented the Federal Circuit from developing two divergent methodologies, one of which is more prone to narrowing the claims by resort to the enabling disclosure (in violation of 35 U.S.C. § 112 and its underlying policies).

3. Respondents mischaracterize the approach the petition urges as the proper one under the statute as a "refusal * * * to recognize virtually any role for the specification [*i.e.*, enabling disclosure] in claim construction." Opp. 14. To the contrary, petitioner endorses a role for the enabling disclosure analogous to that commonly used in contract and statutory interpretation: (1) a court should begin with the text of the patent claims, using ordinary tools of construction in an attempt to discern the ordinary meaning of the claims; (2) *if* at the end of that process the court concludes the claims are ambiguous, then the court may consult the enabling disclo-

sure to resolve the ambiguity. Accord, *Bates v. Coe*, 98 U.S. 31, 38 (1878) (“*in case of doubt or ambiguity it is proper in all cases to refer back to the descriptive portions of the specification * * **”) (emphasis added).⁴

III. THIS CASE PROVIDES AN EXCELLENT VEHICLE FOR RESOLVING THE LONGSTANDING CONFLICT OVER THE PROPER USE OF ENABLING DISCLOSURES IN PATENT CLAIM CONSTRUCTION.

1. Respondents do not contest that this case is an ideal vehicle for this Court to resolve the division within the Federal Circuit over how to interpret patent claims in light of enabling disclosures. The majority below relied on the enabling disclosure to restrict the claims in Izumi’s patent to inner cutter blades that form a 90-degree or smaller angle with the cutting surface. As discussed in the petition (at 26–27), however, the ordinary meaning of the claim terms “recess,” “below,” and “immediately beneath” provides no basis for interpreting the claims to impose such an angular limitation. To the contrary, as the dissent below gleaned from the dictionary and a comparison of the text of claim 1 with that of claim 3 (see Pet. App. 20a–21a), a properly claim-focused

⁴ Additionally, even where the scope of the claims can be discerned from their plain meaning, that scope may be narrowed if the claims or the enabling disclosure *explicitly* disavow that scope or *explicitly* define a claim term in a restrictive way. See Pet. 25 & n.15.

While the prosecution history of Izumi’s patent is “not at issue here” (Opp. 7), we note that this Court’s cases are consistent with the claim-focused approach because they contemplate that only *unequivocal* disclaimers of claim scope during patent application can narrow the claims’ ordinary meaning. See, e.g., *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 733 (2002); *Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966).

approach straightforwardly rejects any angular limitation in this case. Thus, this case requires a choice between legal interpretive approaches, and turns not at all on disputed questions of how these approaches apply to the facts.

Relatedly, respondents have not even attempted to explain how the decision below can be reconciled with the claim-focused interpretive methodology. This again shows that, contrary to respondents' contention, the petition presents a clear legal issue, not simply a dispute over the application of well-settled principles to the facts of this case.

2. The deep intracircuit conflict on patent claim interpretation is no less national in scope than the intercircuit conflicts this Court addresses in other areas of the law: The Federal Circuit has exclusive jurisdiction over patent appeals, which arise from district courts across the country. And "[i]nterpreting the words in the claims is very important in most patent litigation because it is the *first step* in determining * * * whether the patent is infringed * * *." H. SCHWARTZ, *PATENT LAW AND PRACTICE* 110 (4th ed. 2003) (emphasis added). Given the practical consequences that hinge on the choice of methodology, and the deficiencies in the Federal Circuit approach the majority employed below, this Court's review is strongly warranted.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted.

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SUPREME COURT, U.S.

IZUMI PRODUCTIONS COMPANY,
Petitioner,

v.

KONINKLIJKE PHILIPS ELECTRONICS N.V.;
PHILIPS ELECTRONICS NORTH AMERICA CORPORATION
AND PHILIPS DOMESTIC APPLIANCE
AND PERSONAL CARE B.V.,
Respondents.

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

AMICUS CURIAE BRIEF OF
CONEJO VALLEY BAR ASSOCIATION
IN SUPPORT OF NEITHER PARTY

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**Brief Of *Amicus Curiae*
Conejo Valley Bar Association
In Support Of Neither Party¹**

INTEREST OF THE *AMICUS CURIAE*

Based in the heart of Southern California's 101 Technology Corridor, the Conejo Valley Bar Association draws its membership from local law firms and in-house attorneys serving small, mid-market and large companies. Our members' clients are predominantly high tech, high growth companies in fields such as software, biotech, computer networking, telecommunications and semiconductors. Our members' clients are innovators who vend in some of the world's most competitive markets.

The Conejo Valley Bar Association has participated as *amicus curiae* in two recent patent cases decided *en banc* by the Court of Appeals for the Federal Circuit on issues affecting public policies of the patent system, namely *Phillips v. AWH Corp.* and *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*

¹ Pursuant to Supreme Court Rule 37.6, Amicus states that no counsel for a party authorized this brief in whole or in part and that no person or entity other than Amicus, its members, and its counsel contributed monetarily to the preparation or submission of this brief. With the consent of the parties, the Conejo Valley Bar Association submits this brief *amicus curiae* in support of neither party. Copies of the letters of consent are filed with the Clerk of the Court herewith. Originals will be provided in due course.

Amicus curiae writes in *pro bono publico*, rather than in support of either party. We are unconcerned with the outcome of the case, though decidedly concerned about the issues. We wish to see the American public benefit from innovation, from technical disclosure, and from competition in product and service markets. In short, we support the purpose of the patent system. The Conejo Valley Bar Association believes that the patent laws should be interpreted in ways that best serve these important public policies.

The Conejo Valley Bar Association takes an interest in this case because of the potential implications of this Court's ruling on the method of patent claim interpretation.

INTRODUCTION AND SUMMARY OF ARGUMENT

In its petition for writ of certiorari, petitioner frames the question presented and presents arguments that we believe have been sufficiently answered by the rules set forth in *Philips v. AWH Corp.* and other Federal Circuit Court opinions. When patents and their claims do not lend themselves to ready and easy interpretation, reasonable skilled minds will differ on the interpretation of those claims, regardless of the rules provided. When a patent is poorly drafted, it burdens the public – both competitors and the courts – who must discern the claimed patent rights. As such, the controlling theme of controversy in patent cases is not the deficiency of available rules available to interpret patent claims, but the deficiencies in the patents themselves. The Federal Circuit has provided patent counsel with sufficient guidance and rules to allow for claim interpretation in the majority of patents.

ARGUMENT

I. The Federal Circuit Provided Sufficient Claim Interpretation Guidance in *Phillips v. AWH Corp.*

In *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*). 11 of 12 Federal Circuit Court judges agreed on the methodology for claim interpretation. The guidance provided in *Phillips* was neither new nor surprising. The Federal Circuit maintained and reiterated longstanding rules of patent claim interpretation, stating that the claims of a patent do not stand alone and recognizing “the importance of the specification in claim construction.” *Phillips*, 415 F.3d at 1315.² The Federal Circuit also took the long-needed step of rejecting some methodologies which had long stood on the periphery of the jurisprudence of claim interpretation. *Id.* at 1320 (“Although the concern expressed by the court in *Texas Digital* was valid, the methodology it adopted placed too much reliance on extrinsic sources such as dictionaries, treatises, and encyclopedias and too little on intrinsic sources, in particular the specification and prosecution history.”).

² The petitioner uses the term “disclosure” in its petition. For consistency, we use the term “disclosure” herein. However, much of the case law on the subject uses the term “specification.” As such, quotations from cases and analysis of cases use the term “specification.” The terms “disclosure” and “specification” are to be interpreted synonymously herein.

The petition for certiorari attempts to fashion from whole cloth a dramatic distinction between two parts of a patent: the claims and the disclosure. The petitioner argues for a blanket rule that the disclosure of a patent should not be used to interpret the patent's claims if the plain meaning can be unambiguously discerned. Petitioner's Brief, p. 25, 2nd para.

Although the petitioner argues that the disclosure of a patent should not be used to interpret the patent's claims, petitioner's own arguments affirm that the disclosure must necessarily be considered to evaluate whether explicit definitions of claim terms are provided. Petitioner's Brief, p. 13, 1st para and p. 25, 2nd para. Therefore, it can only be concluded that the disclosure must necessarily always be considered when interpreting claims to at least evaluate whether explicit definitions of claim terms are made.

The petitioner proffers a polar analysis that ignores the prosecution history and extrinsic evidence in their entirety, limiting claim interpretation to either the claims on their face or the claims in view of the disclosure when explicit definitions are included in the disclosure. Petitioner's Brief, p. 13, 1st para and p. 25, 2nd para. Wholly absent from the petitioner's brief is a discussion of the distinction between intrinsic evidence and extrinsic evidence. The entirety of available intrinsic and extrinsic evidence should be used to interpret patent claims. *Phillips*, 415 F.3d at 1314 citing *Gemstar-TV Guide Int'l, Inc. v. ITC*, 383 F.3d 1352, 1364 (Fed. Cir. 2004); *Vitronics Corp.*

v. Conceptronic, Inc., 90 F.3d 1576, 1582-83 (Fed. Cir. 1996); and *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979-80 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370, 134 L. Ed. 2d 577, 116 S. Ct. 1384 (1996). In limiting its argument to patent claims and limited use of the disclosure, petitioner ignores substantial pertinent case law, including *Phillips v. AWH*.

Intrinsic evidence includes the disclosure as well as the prosecution history, abstract, summary of the invention and claims as originally filed. The claims themselves and the disclosure are the best and primary source for interpreting claims. See *Phillips*, 415 F.3d at 1315. There are several reasons to review the patent's disclosure. Most importantly, the disclosure must be reviewed for explicit definitions. When a claim or claim term is unclear, the disclosure may also be reviewed for implicit definitions. In some situations, the limitations from the disclosure may be imported into the claim when a claim term is unclear.

Along with the disclosure and other constituent parts of the patent application, the prosecution history must always be reviewed to learn whether any statements were made during prosecution which limit, refine or define any claim terms. *E.g.*, *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005) ("We cannot look at the ordinary meaning of the term . . . in a vacuum. Rather, we must look at the ordinary meaning in the context of the written description and the prosecution history."). There is a long-accepted rule that the prosecution history should be reviewed to

evaluate whether claimed terms have been defined, limited or otherwise given a special meaning by the applicant during prosecution of the patent. *Phillips*, 415 F.3d at 1317 citing *Vitronics*, 90 F.3d at 1582-83 and *Chimie v. PPG Indus., Inc.*, 402 F.3d 1371, 1384 (Fed. Cir. 2005). The prosecution history should be reviewed in all situations, but particularly to evaluate a claim term that is unclear. The prosecution history may include an express disclaimer of the scope of a claim or claim term. See *Phillips*, 415 F.3d at 1317. The prosecution history should also be reviewed to evaluate whether equivalents to claim terms are available.

Extrinsic evidence may also be used when evaluating claims, particularly in those cases where no clear interpretation of the claims can be made. Extrinsic evidence in the form of dictionaries, treatises, and other works in publication as of the filing date of the patent should be considered to learn how one skilled in the relevant art at the time the patent was filed would interpret or understand claim terms. See *Phillips*, 415 F.3d at 1318, 1322. Extrinsic evidence may be used to verify or confirm the meaning of claim terms, and may also be used to interpret unclear claim terms when the intrinsic evidence did not yield a clear result.

The petitioner-recommended analysis is untenable in view of the long history of consultation of both the prosecution history and extrinsic sources in claim interpretation.

We maintain the recommendation we provided in our *amicus* brief in *Phillips v. AWH* in which we suggested an iterative approach that takes into consideration available patent rules. As we explained in that *amicus* brief, rarely is claim construction readily discernable upon an initial read of the disclosure and claims on the one hand or a quick resort to dictionaries and treatises on the other. Claim interpretation typically requires careful analysis of the whole of the intrinsic and extrinsic evidence.

Certainty of claim scope may be enhanced by a successive refinement of claim analysis based on review of the intrinsic evidence and the extrinsic evidence. For example, the patent's disclosure may provide only examples, a dictionary may provide several definitions, and the prosecution history may provide indicia of which definitions are apt. The goal should be not to follow a rigid guideline, but to achieve the desired end result - a claim interpretation commensurate with the breadth of the invention set forth by the inventor in the disclosure as of the earliest priority date.

The successive refinement approach is set forth in the following drawing.

